

U.S. Application No. 09/863,044
Office Action dated September 7, 2005

PATENT
450100-03235

REMARKS/ARGUMENTS

Reconsideration and withdrawal of the rejections of the application are respectfully requested in view of the amendments and remarks herewith. The present amendment is being made to facilitate prosecution of the application.

I. STATUS OF THE CLAIMS AND FORMAL MATTERS

Claims 1-17, 19-44, and 46-54 are currently pending. Claims 1 and 28 are independent. Claims 1, 8, 15-16, 26-28, 35, 42-43, 51, and 53-54 are hereby amended. Claims 18 and 45 are hereby canceled, without prejudice or disclaimer of subject matter. The subject matter of claims 18 and 45 has been incorporated into independent claims 1 and 28, respectively.

Claims 8, 15-16, 35, and 42-43 were objected to because of a minor informality. The present amendment obviates the rejection.

No new matter has been introduced by this amendment. Changes to the claims are not made for the purpose of patentability within the meaning of 35 U.S.C. §101, §102, §103, or §112. Rather, these changes are made simply for clarification and to round out the scope of protection to which Applicants are entitled.

II. REJECTIONS UNDER 35 U.S.C. §102(e)

Claims 1-5, 7-17, 19-22, 26-32, 34-45, 47-49, and 53-54 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by U.S. Patent No. 6,801,713 to Yagawa et al. (hereinafter, merely "Yagawa").

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Claim 1 recites, *inter alia*:

“... virtual channel management means for assigning virtual channels every category, while setting said broadcasting programs, sorted into said categories, in array on an associated virtual channel in a reproduction start order, said virtual channel management means locates previously located programs in an overlap array when a period of a future spare time is not filled with the broadcasting programs ...” (Emphasis added)

As understood by Applicants, Yagawa relates to a support method for helping the user find a desired program from a collection of recorded television programs.

Applicants respectfully submit that nothing has been found in Yagawa that would teach or suggest the above-identified feature of claim 1. Specifically, Yagawa does not teach or suggest that the virtual channel management means locates previously located programs in an overlap array when a period of a future spare time is not filled with the broadcasting programs, as recited in claim 1.

Indeed, the Office Action concedes on page 9 that “Yagawa fails to teach the system for recording and/or reproducing broadcast programs according to claim 1, wherein said virtual channel management means is to locate already located programs in overlap array when a period of a future spare time is not filled with the programs” (emphasis added). The Office Action relies on U.S. Patent No. 6,240,240 to Nagano et al. (hereinafter, merely “Nagano”) to teach this feature. However, as explained in detail below in Section III of these Remarks, Nagano is disqualified as prior art to the present application under the provisions of 35 U.S.C. §103(c).

Therefore, Applicants respectfully submit that claim 1 is patentable.

Claim 28 is a corresponding method claim, which is similar in scope, and is therefore patentable for similar reasons.

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III. REJECTIONS UNDER 35 U.S.C. §103(a)

A. CLAIMS 18 and 45

Claims 18 and 45 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yagawa in view of Nagano (U.S. Patent No. 6,240,240).

Nagano is disqualified as §103 prior art to the present application under the provisions of 35 U.S.C. §103(c). Under the provisions of 35 U.S.C. §103(c), subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f) and (g) of 35 U.S.C. §102, shall not preclude patentability under §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person or organization.

More specifically, M.P.E.P. §2146 states:

These changes to 35 U.S.C. 103(c) apply to all patents (including reissue patents) granted on or after December 10, 2004. The amendment to 35 U.S.C. 103(c) made by the AIPA to change "subsection (f) or (g)" to "one or more of subsections (e), (f), or (g)" applies to applications filed on or after November 29, 1999. It is to be noted that, for all applications (including reissue applications), if the application is pending on or after December 10, 2004, the 2004 changes to 35 U.S.C. 103(c), which effectively include the 1999 changes, apply; thus, the November 29, 1999 date of the prior revision to 35 U.S.C. 103(c) is no longer relevant. (Emphasis added)

Nagano and the present application were, at the time the present invention was made, subject to an obligation of assignment to the same organization, i.e., Sony Corporation. Such obligation is evidenced by the recording of assignment documents in the U.S. Patent and Trademark Office.

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Accordingly, Nagano is disqualified as prior art in a rejection under 35 U.S.C. §103(a); and thus all of the outstanding rejections based upon Nagano in the above-noted Office Action are overcome.

Therefore, Applicants respectfully submit that claims 18 and 45 are patentable.

B. CLAIMS 6, 23-25, 35, and 50-52

Claims 6, 23-25, 35, and 50-52 were rejected under 35 U.S.C. §103(a) as allegedly unpatentable over Yagawa in view of U.S. Patent No 5,999,691 to Takagi et al. (hereinafter, merely "Takagi").

As understood by Applicants, Takagi relates to a television receiver.

Applicants respectfully submit that Takagi fails to teach or suggest the disclosure missing from Yagawa.

Claims 6, 23-25, are dependent from claim 1, and claims 35, and 50-52 are dependent from claim 28, discussed above, and are therefore patentable for at least those reasons.

IV. DEPENDENT CLAIMS

The other claims in this application are each dependent from one of the independent claims discussed above and are therefore patentable for at least the same reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, however, the individual reconsideration of the patentability of each on its own merits is respectfully requested.

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CONCLUSION

In the event the Examiner disagrees with any of statements appearing above with respect to the disclosure in the cited references, it is respectfully requested that the Examiner specifically indicate those portions of the references providing the basis for a contrary view.

Please charge any additional fees that may be needed, and credit any overpayment, to our Deposit Account No. 50-0320.

Applicant respectfully submits that all of the claims are in condition for allowance and requests early passage to issue of the present application.

Respectfully submitted,

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